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Claudia Pinzon

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EXAMINER

OGDEN JR, NECHOLUS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLAUDIA PINZON, LAURA SCHICK, and
WALTER J. CARMODY

Appeal 2009-005136
Application 10/722,878
Technology Center 1700

Decided: November 24, 2009

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1-29 (Final Office Action ("Final"), mailed Aug. 18, 2005), the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Independent claims 1 and 19 are illustrative of the subject matter on appeal, and are reproduced from the Claims Appendix to the Appeal Brief (“Br.”), filed Sep. 5, 2007:

1. A topical aqueous cleansing composition,
comprising:

about 0.05 wt% to about 20 wt% of one or more waxes
having a melting point of about 70 °C or more;

an anionic surfactant and an additional surfactant selected
from the group consisting of a nonionic surfactant, an
amphoteric surfactant, and a combination of a nonionic
surfactant and an amphoteric surfactant, in an amount effective
to stabilize the wax in the composition; and

about 20 wt% or more water.

19. The composition of claim 1, wherein the
composition is in the form of a dispersion.

Appellants request review of the sole ground of rejection (Br. 4):
claims 1-29 under 35 U.S.C. § 103(a) as unpatentable over Dufay, US.
2002/0010114, published Jan. 24, 2002.

Appellants present separate arguments in support of patentability of
claims 19, 22, and 25, as a group. The remaining claims stand or fall with
claim 1.¹

¹Although Appellants place claims 2-10, 21, and 24 under a separate
subheading (Br. 7), they do nothing more than point out what the claims
recite. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points
out what a claim recites will not be considered an argument for separate
patentability of the claim.”).

The following issues are presented for our review:

1. Have Appellants shown that the Examiner's findings are insufficient to establish that it would have been obvious to have selected a wax and an anionic surfactant as recited in claim 1 for use in Dufay's aqueous cleaning concentrate?

2. Have Appellants shown that the Examiner reversibly erred in finding that Dufay discloses or suggests a composition in the form of a dispersion as recited in claims 19, 22, and 25?

We answer both questions in the negative for the reasons expressed on pages 4-7 of the Examiner's Answer (mailed Dec. 21, 2007 ("Ans.")), to which we add the following discussion of the relevant case law and its applicability to the facts in this appeal. *See Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1366 (Fed. Cir. 2007) (quoting *In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992) ("Every case, particularly those raising the issue of obviousness under section 103, must necessarily be decided upon its own facts.")).

Appellants contend that the Examiner erred in rejecting the claims as obvious in view of Dufay because considerable picking and choosing is necessary to achieve the claimed invention.

An obviousness rejection predicated on selection of one or more components from numerous possible choices may be appropriate if the prior art provides direction as to which of many possible choices is likely to be successful, *see PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1364 (Fed. Cir. 2007), e.g., "where the prior art 'contain[s] detailed enabling methodology for practicing the claimed invention, a suggestion to

modify the prior art to practice the claimed invention, and evidence suggesting that it [will] be successful,” *In re Kubin*, 561 F.3d 1351, 1360 (Fed. Cir. 2009) (quoting *In re O’Farrell*, 853 F.2d 894, 902 (Fed. Cir. 1988) (emphasis added)). *See also*, *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (prima facie case of obviousness established where the Examiner demonstrates that the invention is nothing more than the predictable result of a combination of familiar elements according to known methods); *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1166-67 (Fed. Cir. 2006).

Based on the Examiner’s factual findings (Ans. 3-4), we determine that Dufay would have clearly guided the ordinary artisan toward selection of waxes and surfactants within the scope of appealed claim 1, since Dufay specifically identifies many of the same waxes and surfactants used by Appellants (*compare* Dufay, ¶ [0064] *with* Spec. 4:5-18 *and* Dufay, ¶ [0060] *with* Spec. 5:26-6:7) as suitable for use in Dufay’s final compositions (*see* Dufay, ¶ [0058]). As indicated in both Dufay and Appellants’ Specification, it is well known in the art to use these waxes and surfactants in skin cleansers (Dufay, ¶ [0060] (“The surfactants mentioned are all known compounds.”); Spec. 4:13-16 and 6:4-6 (citing the International Cosmetic Ingredient Dictionary and Handbook)). *See Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 808 (Fed. Cir. 1989) (*citing In re Corkill*, 771 F.2d 1496, 1500 (Fed. Cir. 1985) (obviousness rejection of claims affirmed in light of prior art teaching that “hydrated zeolites will work” in detergent formulations, even though “the inventors selected the zeolites of the claims from among ‘thousands’ of compounds”)); *In re Susi*, 440 F.2d 442, 445 (CCPA 1971) (obviousness rejection affirmed where the disclosure of the

prior art was “huge, but it undeniably include[d] at least some of the compounds recited in appellant's generic claims and [was] of a class of chemicals to be used for the same purpose as appellant's additives”). Moreover, the Examiner’s obviousness determination is not based on varying numerous parameters in Dufay; rather, the principal parameter which must be varied to achieve the claimed invention is the quantity of wax present in the final composition. It is well settled that “discovery of an optimum value of a variable in a known process is usually obvious.” *Pfizer*, 480 F.3d at 1368; *see also, Medichem*, 437 F.3d at 1168 (*citing In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) (The ““normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.””)); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955) (noting that it is normally “expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification” over the prior art).

With respect to claims 19, 22, and 25, Appellants additionally argue that the Examiner erred in failing to fully explain why Dufay’s teaching of a composition in the form of an emulsion suggests a composition in the form of a dispersion as claimed. The Examiner fully addressed this argument on page 6 of the Answer, and Appellants have not filed a Reply Brief in response. Because Appellants have not provided arguments or evidence establishing that the Examiner’s findings and reasons on page 6 of the Answer are incorrect, we determine that Appellants have not shown reversible error in the Examiner’s obviousness determination as to claims 19, 22 and 25. *See, e.g., In re Fox*, 471 F.2d 1405, 1407 (CCPA 1973)

(affirming the Board's decision: "In this court appellant has not denied the existence of the facts on which the examiner rested his obviousness rejection nor the added facts of which the board took judicial notice."); *In re Kunzmann*, 326 F.2d 424, 425 n.3 (CCPA 1964) ("[T]he examiner appears to have considered thoroughly this assertion, and to have found otherwise. Since appellant has not shown this finding to be clearly erroneous, we accept it as fact.").

In sum, for the reasons stated in the Examiner's Answer and expanded upon above, we determine that Appellants have not identified reversible error in the Examiner's obviousness determination.

The decision of the Examiner rejecting claims 1-29 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

kmm

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